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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,092	01/27/2006	Dimitri Leroy	284224US0PCT	9556
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SERGENT, RADON A				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/31/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/566,092

Applicant(s)

LEROY ET AL.

Examiner

Rabon Sergeant

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date 1/27/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

1. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Within claim 1, the language, “at least one of which is substantially close to the use temperature of the material”, lacks description and objective meaning to such an extent that the claims are rendered virtually meaningless. Firstly, it is unclear what is meant by the language, “substantially close”, in that it cannot be determined what constitutes “close” or how “substantially” further modifies “close”. Secondly, there is no means for determining exactly what constitutes a “use temperature” or what numerical temperature is encompassed by the language. Accordingly, there is no way of determining what glass transition temperature is encompassed by the claims. Though applicants set forth a range of glass transition temperatures within claim 3, it cannot be determined how to reconcile the language of claim 1 with the claimed ranges. It is noted that claim 11 also refers to the “use temperature”, and the position is taken that its use within claim 11 is similarly lacking in description and meaning. Furthermore, with respect to claims 1-20, it is unclear to what extent the claimed loss factor is dependent on temperature.

2. Claims 1-4 and 10-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions disclosed at page 3, lines 4-17 of the specification, does not reasonably provide enablement for the production of compositions having the claimed properties from virtually any materials. The specification does not enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicants have provided no guidance for the production of damping materials having the claimed properties from components other than those set forth within page 3, lines 4-17, and the position is taken that applicants' claims should be limited to the invention for which they have provided enablement. Consonant with the requirements set forth within *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (MPEP 2164.01), the relevant undue experimentation factors have been analyzed as follows:

The Breadth of the Claims

Applicants' claims have been considered, and they are drawn to a damping material comprising a single constituent having a loss factor of at least 0.25 and having two glass transition temperatures; however, the claims possess no limitations with respect to the components of the composition.

The Nature of the Invention

The invention is drawn to the production of acoustic damping and bonding properties, wherein it is disclosed that materials that have such features correspond to the materials set forth within page 3 of the specification.

The Amount of Direction Provided by the Inventor

Aside from disclosing the the use of the argued components within page 3 of the specification and providing further guidance pertaining specifically to their chemical properties and constitution, the inventors fail to provide any guidance governing the use of materials

beyond the scope of those of page 3 of specification to yield damping materials having the claimed properties.

The Existence of Working Examples

The examples set forth within the specification are drawn to the use of polyurethane compositions that fall within the scope of the compositions encompassed by the disclosure within page 3 of the specification; therefore, the examples provide no guidance in practicing the invention with the full scope of materials encompassed by the claims.

The Quantity of Experimentation Needed to Make or Use the Invention

Based on the Content of the Disclosure

Since the disclosure fails to exemplify the production of damping materials from other than polyurethanes and since applicants fail to provide any specific guidance concerning how one would produce damping materials having the claimed properties from components other than those disclosed, the position is taken that extensive experimentation would be required to make the invention of the scope claimed.

Therefore, in view of the analysis of these factors, the position is taken that one of ordinary skill could not practice the invention as claimed without having to resort to undue experimentation.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the language, “at least one of which is substantially close to the use temperature of the material”, render the claims indefinite. Firstly, the term, “close”, is

subjective language; it cannot be determined what quantitatively constitutes "close".

Furthermore, it is unclear how "substantially" further modifies "close"; it cannot be determined if or to what extent "substantially close" is different from "close". Secondly, it is unclear how to interpret the reference to "use temperature" or how one could possibly determine the quantitative value intended by the language. Furthermore, it is unclear how to interpret exactly what value of glass transition temperature is encompassed by the language. The position is ultimately taken that the language is so vague and ambiguous that the claims are rendered unintelligible. One of ordinary skill cannot determine from the language exactly what glass transition temperature is required to be possessed by the damping material. It is noted that claim 11 also refers to "use temperature"; however, the term is similarly indefinite in this claim. There is no means for determining the temperature condition of the claim.

With respect to claim 5, it is noted that applicants have not specified the components of a) and b) in the alternative; therefore, it is unclear if at least one of every component of a) and b) is required. As drafted, the claim is clearly open to this interpretation.

With respect to claims 5 and 6, the multiple use of the language, "based", renders the claims indefinite, because it is unclear how or to what extent the respective prepolymers and polyurethane are derived from the recited polyols.

With respect to claims 5, 7, 8, 9, 14, and 20, the use of "type" so extends the scope of the terms that they are rendered indefinite. *Ex parte Copenhaver*, 109 USPQ 118.

With respect to claim 6, the subject matter fails to further limit claim 5, because the components of claim 5 are not claimed in terms of being prepolymers.

With respect to claims 7-9, it is unclear how to reconcile the limitations of these claims, because the components are not recited in terms of being prepolymers, yet claim 6, the claim from which claims 7-9 depend, positively require a blend of at least two prepolymers.

With respect to claim 8, the upper end of the NCO value range exceeds the range set forth within claim 7, and with respect to claims 8 and 9, it is unclear how to reconcile the recited components in view of the language or components of claim 7. It is unclear if different compositions of prepolymers are some how intended by the language or if the claims simply fail to further limit claim 7.

With respect to claim 11, the language, “the strip”, lacks antecedent basis from claim 1.

With respect to claim 12, the language, “the terminal isocyanates of the prepolymers” and “the monols”, lacks antecedent basis from claim 1. Furthermore, it is unclear what “its” refers to.

With respect to claims 12, 13, 14, and 18, the language denoted by “intended” does not constitute a definitive limitation or a defined structure.

With respect to claim 19, the reference to two different claims is improper.

4. The severity of the issues under 35 USC 112, first and second paragraphs, prevent determining the metes and bounds of the claimed invention and therefore preclude any meaningful search or interpretation of the prior art.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796